

REMARKS

The above amendments and these remarks are responsive to the Office Action issued on November 3, 2004. By this response, claim 12 is amended, claim 3 is cancelled and claim 14 is newly presented. No new matter is added. Claims 1 and 5-11 were withdrawn in view of a previous restriction requirement. Claims 2, 4 and 12-14 are now active for examination. An information disclosure statement is submitted concurrently herewith.

The Office Action dated November 3, 2004 rejected claims 2-4, 12 and 13 under 35 U.S.C. §103(a) as being unpatentable over Masuda (U.S. Patent No. 6,144,858) in view of Chang (U.S. Patent No. 6,188,890). The rejection is respectfully traversed in view of the claim amendment and remarks presented herein.

The Rejection of Claim 3 Is Moot

By this Response, claim 3 is cancelled without prejudice. Therefore, the rejection of claim 3 is now moot.

The Rejection of Claims 2, 4, 12 and 13 Is Traversed

Claims 2-4, 12 and 13 were rejected as being unpatentable over Masuda in view of Chang. The rejection is respectfully traversed because Masuda and Chang cannot support a prima facie case of obviousness.

By this Response, claim 12 is amended and describes a mobile unit configured to receive an intensity control signal from a base station for controlling the intensity of an uplink signal sent by the mobile unit. Responsive to receipt of an intensity control signal for maximizing the intensity of the uplink signal while a downlink signal is received by the mobile unit normally, the mobile unit generates an alarm associated with the uplink signal. Appropriate support for the

amendment can be found in, for example, Fig. 4 and page 15, second paragraph through page 17, third paragraph of the written description. Therefore, a mobile unit according to claim 12 is able to determine a reception condition of the base station regarding the uplink signal transmitted by the mobile unit, based on a feedback signal (the intensity control signal) provided by the base station indicating whether the intensity of the uplink signal needs to be increased in order to improve the reception quality.

In contrast, Masuda describes a mobile terminal that measures the electric field intensity of a signal transmitted from a base station, in order to determine whether the quality of the signal transmitted from the base station is acceptable. However, Masuda does not determine whether the reception condition on the base station side regarding a signal transmitted by the mobile terminal is acceptable. Furthermore, as correctly acknowledged by the Examiner, Masuda also fails to disclose generating an alarm in response to receipt of an intensity control signal for maximizing the intensity of the uplink signal.

Chang does not alleviate the deficiency of Masuda. Chang was cited by the Office Action for describing triggering an alarm when the quality of a signal transmitted from the base station is not acceptable. Chang, however, does not teach or suggest determining whether the reception condition on the base station side regarding a signal transmitted from the mobile terminal is acceptable, as described in claim 12. Moreover, Chang also fails to disclose that the alarm is generated in response to receipt of an intensity control signal for maximizing the intensity of the uplink signal, as described in claim 12.

Therefore, Masuda and Chang, even combined, do not teach every limitation of claim 12 and cannot support a prima facie case of obviousness. The obviousness rejection of claim 12 is

untenable and should be withdrawn. Favorable reconsideration of claim 12 is respectfully requested.

Claims 2, 4 and 13 depend on claim 14 and incorporate every limitation thereof. Since claim 1 is patentable over Masuda and Chang, claims 2, 4 and 13 also are patentable over Masuda and Chang by virtue of their dependencies from claim 1. Favorable reconsideration of claims 2, 4 and 13 is respectfully requested.

New Claim 14 Is Patentable

By this Response, claim 14 is newly presented and depends from claim 12. As claim 1 is patentable over the publications made of record, it is submitted that claim 14 also is patentable through its dependency from claim 12. Favorable consideration of claim 14 is respectfully requested.

For the reasons given above, Applicants believe that this application is conditioned for allowance and Applicants request that the Examiner give the application favorable consideration and permit it to issue as a patent. However, if the Examiner believes that the application can be put in even better condition for allowance, the Examiner is invited to contact Applicants' representatives listed below.

Application No.: 09/842,913

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

A handwritten signature in black ink that reads "Wei-Chen Chen". The signature is written in a cursive, flowing style.

Wei-Chen Nicholas Chen
Recognized under 37 CFR §10.9(b)

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